



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/552,818

10/11/2005

Bernhard Gleich

DE030118US1

5552

24737

7590

11/23/2010

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

DEJONG, ERIC S

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

11/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,818	Applicant(s) GLEICH, BERNHARD	
	Examiner ERIC S. DEJONG	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-40 is/are pending in the application.
- 4a) Of the above claim(s) 6,8,9 and 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,11,15-19 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

Applicants response filed 09/07/2010 is acknowledged.

Claims 1-19 and 36-40 are pending.

Claims 20-35 are cancelled. Claims 6, 8, 9, and 12-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species for the First Species election requirement, there being no allowable generic or linking claim. See the Restriction Requirement mailed 01/07/2010. Further, dependent claim 3 has been examined only to the extent of the elected species of examination objects, a Thermoplastic Polymer. Election was made without traverse in the reply filed on 02/08/2010. Claims 1-5, 7, 10, 11, 15-19, and 36-40 are currently under examination.

Claim Objections

Claims 6, 8, 9, and 12-14 are objected to because of the following informalities: Claims 6, 8, 9, and 12-14 are withdrawn from consideration, however the claim set filed 09/07/2010 improperly lists said claims as (previously presented). Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 7, 10, 11, 15-19, and 36-40 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The instant claims are drawn to a method for the spatially resolved determination of physical, chemical, and/or biological properties or state variable. The claimed process comprises the steps of introducing coated magnetic particles having a coating into a least part of an examination area, detecting signals derived from generating and changing magnetic fields present in said examination area, and evaluation signals to obtain information the magnetic particles in the examination area.

However, the instant claims do not recite any particular improvement or resultant characteristic that is imparted to proteins generated by the instant method or how analysis of the resultant secondary protein sequences would be used to yield any useful information.

However, the instant claims are generic with respect to the particular physical, chemical, and/or biological property or state variable that that is under investigation. Further, the instant claims are silent with regards to the steps involved in evaluating and unspecified signal derived from varying magnetic field strengths in the presence of a magnetic particle. Therefore, fail to specify what useful information would necessarily result from practicing the instant claims.

The Court of Patent and Appeals has stated:

"Practical utility is a shorthand way of attributing "real-world" value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public." A 'use' to do further research is not considered a utility which provides an "immediate benefit" to the public.
Examples of situations requiring further research to identify or reasonably confirm a "real world" context of use, and which do not have utility under 35 USC 101, as set forth in MPEP 2107.01.1, include:

Art Unit: 1631

- (A) Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved, and
(C) A method of assaying for or identifying a material that itself has no specific and/or substantial utility.

In the instant case, the claimed invention encompasses a process of basic research drawn to studying unspecified properties (physical, chemical, and/or biological or state variables) by means of unspecified evaluation process of signals derived from varying magnetic field strengths in the presence of a magnetic particle. The instant claims fail to specify any particular property and, further, fail to specify the a particular series of steps for evaluating signals so as to obtain a meaningful evaluation of spatial distribution and/or particle mobility. As such, the instant claims do not result in an “immediate benefit” to the public. As noted in the utility guidelines (see Federal Register, December 21, 1999, Vol. 64, No. 244), basic research on a product to identify properties is an insubstantial utility (see page 6 of the Utility guideline training materials). Therefore, the instant claims lack a specific and substantial utility.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 7, 10, 11, 15-19, and 36-40 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Response to Arguments

Applicant's arguments filed 09/07/2010 have been fully considered but they are not persuasive.

It is first noted that the basis of instant rejection is a lack of either a specific or substantial utility set forth under 35 USC 101. Therefore, applicants arguments directed to the claim being rejected on the basis of a non-statutory subject matter basis under 35 USC 101, is not germane. Therefore, the examiner has not responded to arguments directed to non-statutory subject matter because there is no grounds of rejection on that basis currently of record.

Applicants argue that the instant claims are a method that is a new and useful process for the determination of a number of possible variable.

In response, the examiner maintains that a process directed to determining unspecified properties of a sample or molecules has neither a specific nor substantial utility recognized under 35 USC 101.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1631

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC S. DEJONG whose telephone number is (571)272-6099. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC S. DEJONG/
Primary Examiner, Art Unit 1631